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REMARKS
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***Amendment to the Claims***

No amendments have been made to claims 16-30. Claim 31 is the same as claim 16 but the phrase "consisting essentially of" has been entered instead of "comprising". It is believed that no new matter has been added.

***Double-Patenting Rejection***

- (1) Claims 16, 19 and 23 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting rejection over application SN: 09/641,013. As neither this application nor the '013 application have been allowed, The examiner is reminded that MPEP 822.01 recites that "If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. See also MPEP § 804.01 and § 822."
- (2) Claims 16, 19 and 23-25 were rejected under the judicially created doctrine of obviousness-type double patenting rejection over Gers-Barlag et al. (U.S. Patent 6,592,883) in view of Fänger et al. (U.S. Patent 6,153,204).

A terminal disclaimer has been filed over U.S. Patent 6,592,883. However, in light of *Festo*, the applicants state for the record that the above rejection is in error and the terminal disclaimer is being filed for a obviousness-type double patenting rejection over U.S. Patent 6,592,883 alone.

***35 U.S.C. 103(a) rejection***

Claims 16-30 were rejected as being obvious over Fänger et al. (U.S. Patent 6,153,204) in view of Msika et al. (U.S. Patent 5,939,054)

***Introduction***

The applicants and the examiner have essentially maintained their positions during the last couple of office actions. While the applicants maintain their previous positions, a different approach to the rejection

1 MPEP 804 states "Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the claimed subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude the granted by a patent....When considering whether an invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.

As the use of the secondary reference does not appear to be for 'dictionary' purposes, the combination of references is presumed to constitute a *Schneider*-type nonstatutory double patenting rejection. MPEP 804 in addressing these types of rejections states "Non-statutory double patenting rejections based on *Schneider* will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneider*...the examiner should first consult with his or her supervisor (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained..." There is no indication from the Office Action that these procedures were performed.

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is presented below in addition to a re-emphasis of a difference which is not addressed by the prior art.

Was the Invention Suggested at the Time the Application Was Filed?

MPEP 2141.01 sect. III discussed the need to determine the content of the prior art at the time the invention was made to avoid hindsight. The courts have also supported this premise. *In re Fine*, see *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) discusses in length about the standard with which prior art references should be viewed:

"Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art.' *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.' *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And 'teachings of references can be combined *only* if there is some suggestion or incentive to do so.' *Id.* Here the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination...

It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention and *cast the mind back to the time the invention was made...* to occupy the mind of one skilled in the art *who is presented only with the references*, and who is normally guided by the then-accepted wisdom in the art.' *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 5 USPQ2d 1599, 1600.

In *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993) (relying on *Fine*) it was further stated that "[a]bsent such suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reasoning is impermissible." *Id.* at 1029.

As examiners often reflexively invoke *In re McLaughlin* (see MPEP 2145, section X. A.) when confronted with hindsight reconstruction arguments, it is important to point out that the ruling in *Fine*, *Texas Instruments* and *McLaughlin* are not incompatible and are different ways of expressing the same concept, i.e. applicants' specification and claims cannot be used as a template to determine whether: (1) the primary reference could have been modified; and (2) if the primary reference could have been modified that there was sufficient suggestion and motivation to do so.

Applying these standards to the facts at hand, the question becomes:

"As of 17 August 2000 (the filing date of this application), would one of ordinary skill in the art have been directed or have had motivation to modify the teachings of Fänger et al. to arrive at the presently claimed invention when not having the luxury of the applicants claims to provide them with any guidance as to how to modify Fänger et al.'s teachings?"

The answer is no.

At the most basic level, the claims of Fänger et al. are directed toward a method of use wherein the composition/preparation used must contain a hydrophilic starch esterified with one or more n-octenylsuccinate radicals. As such, the Fänger et al. reference is inapplicable to the scope of the applicants' claims where hydrophilic starch esterified with one or more n-octenylsuccinate radicals are not present.

In addition, the hydrophilic starch esterified with one or more n-octenylsuccinate radical is the only required element of the Fänger et al. composition. All of the other ingredients of Fänger et al.'s disclosure

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may be part of the preparation but there is no requirement for them to be present. As such, when taking each of the possible additional elements, the Fänger et al. reference teaches a virtual infinite number of possible permutations of the composition/preparation.

*In re Rice*, 178 USPQ 478, 480 (CCPA 1973) also speaks to the issue of obviousness and hindsight reconstruction and stated that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480. Applying the standard of *Rice* to the present application, if the present claims were not before a skilled artisan, what is the suggestion or motivation for one of ordinary skill in the art to look at the entirety of possible permutations suggested by Fänger et al. and magically select a modified phyllosilicate particle with amphiphilic character, i.e. where is the factual support for the examiner's assertion that it would have been obvious to exemplify a particular embodiment of the invention when confronted with an infinite number of choices?

There is none.

Moreover, the applicants' claims include the limitation that there is at most 0.5% by weight of an emulsifier based on the total weight of the preparation. Fänger et al. recites a Markush-like group of additional ingredients which may be present in the preparation (see e.g. col. 6, lines 63 - col. 7, lines 6) which includes emulsifiers. However, Fänger et al. is not only silent about the amount of emulsifier but also does not specifically teach the concept of a specific range of emulsifier content (i.e. 0 - 0.5% by weight) in combination with a modified phyllosilicate particle with amphiphilic character as in the applicants' claimed invention." Again, applying the standard of *Rice* to the present application, if the present claims were not before a skilled artisan, what is the suggestion or motivation for one of ordinary skill in the art to look at the entirety of possible permutations suggested by Fänger et al. and magically select a modified phyllosilicate particle with amphiphilic character and the specific range of emulsifiers? There is none.

The Msika et al. reference does not remedy the differences of the Fänger et al. reference stated above and moreover is incompatible with the applicants' claimed invention, i.e. when speaking to the issue of water-in-oil emulsions, Msika et al. discloses that the emulsifying system is between 4 and 35% by weight which is well in excess of the applicants' claimed range (see col. 4, lines 32-37).

Msika et al. has its own "infinite number" of permutations for their invention and as such it is unclear how one of ordinary skill in the art would be able to pick and choose teachings for combination with Fänger et al. especially in light of the fact that the emulsion ranges are different between the two types of water-in-oil emulsions represented by Fänger et al. and Msika et al.

#### Conclusion

The applicants' claims are unobvious in light of Fänger et al. and Msika et al. as at best Fänger et al. could only cover a portion of the applicants' invention (i.e. the preparations of the applicants' invention which contain hydrophilic starch esterified with one or more n-octenylsuccinate radicals). Even under an interpretation of Fänger et al. most favorable to the examiner's position, there is still no teaching or suggestion to select a modified phyllosilicate particle with amphiphilic character with the emulsifier weight ranges claimed by the applicants. Moreover, even if it could be shown that Msika et al. adequately speaks to the modified phyllosilicate particle with amphiphilic character, this would only be within the context of a water-in-oil emulsion with 4-35% by weight emulsifier and as such the teachings are incompatible with the emulsifier ranges which must be assumed for Fänger et al. in order to meet the limitations of the

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applicants' claims.

For these reasons, it is presented that Fänger et al. in view of Msika et al. does not render the applicants' claimed invention to be obvious.

**Closing**

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 7 November 2003

By: Agata Glinska  
Agata Glinska